

REMARKS/ARGUMENTS

In the Office action mailed August 12, 2009, claims 1 – 21 were rejected. In response, Applicants have amended claims 12 and 21. Applicants hereby request reconsideration of the application in view of the amended claims and the below-provided remarks. No claims have been added or canceled.

For reference, claims 12 and 21 have been amended to correct a problem with antecedent basis. In particular, the first instance of the term “said apparatus” has been changed to “an apparatus.” Applicants assert that this amendment does not change the scope of the claim.

Claim Rejections under 35 U.S.C. 103

Claims 1 – 21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Pat. No. 7,233,316). However, Applicants respectfully submit that these claims are patentable over Smith for the reasons provided below.

Claim 1

Claim 1 recites:

“An apparatus for controlling a base device, comprising:
a memory; and
at least one processor, coupled to the memory, operative to:
detect a motion of said apparatus;
interpret said motion to identify a command that triggers a transfer of data between said apparatus and said base device; and
execute said command.” (emphasis added)

As recited in claim 1, a motion is interpreted to identify a command “that triggers a transfer of data between said apparatus and said base device.”

In support of the rejection of claim 1, the Office action states:

“Regarding claim 1, Figure 3 and col. 4 – 5 teaches a remote controller that detects motion of the apparatus and interprets the motion to identify a command and executes the command. Smith does not explicitly teach a memory and a processor. It is conventional for a remote control to include a processor and

memory. It would have been obvious to use conventional means for their known functionality.” (Office action, page 2)

Applicants assert that a *prima facie* case of obviousness has not been established because 1) the Office action does not address each limitation of the claim and 2) Smith does not teach that a motion is interpreted to identify a command “that triggers a transfer of data between said apparatus and said base device” as recited in claim 1.

With regard to item 1, the Office Action fails to explain why the claimed limitations of claim 1 would have been obvious because the Office action does not acknowledge the actual language of claim 1. In particular, the Office action fails to acknowledge that claim 1 recites that a motion is interpreted to identify a command “that triggers a transfer of data between said apparatus and said base device.” (emphasis added) In fact, the Office action does not even make an assertion that Smith might describe the indicated limitation, or that the indicated limitation might otherwise be obvious in light of Smith. Therefore, the Office action fails to establish a *prima facie* rejection for claim 1 because the Office action does not assert or show how Smith might teach every limitation of the claim. Accordingly, Applicants respectfully submit that the rejection of claim 1 under 35 U.S.C. 103(a) should be withdrawn.

With regard to item 2, Smith teaches that the motion of a hand-held device is interpreted to identify a command. The identified command is related to interacting with a user interface of a computer, e.g., a user interface for a television. Figs. 4A – 7B depict various screen shots of a user interface and Fig. 3 illustrates various gestures that are translated to commands for interacting with the user interface. However, Smith does not teach a command “that triggers a transfer of data between said apparatus and said base device” as recited in claim 1. In fact, Smith makes no mention of a need to desire to transfer data from the controller (see Fig. 2, 200) to the computer (see Fig. 1, 120).

Because the Office action does not address each limitation of the claim and because Smith does not teach that a motion is interpreted to identify a command “that triggers a transfer of data between said apparatus and said base device,” Applicants assert that a *prima facie* case of obviousness has not been established with regard to claim 1.

Independent Claims 12 and 21

Applicants respectfully assert that independent claims 12 and 21 are patentable over Smith at least for similar reasons to those stated above in regard to the rejection of independent claim 1. Although the language of these claims differs from the language of claim 1, and the scope of these claims should be interpreted independently of other claims, Applicants respectfully assert that the remarks provided above in regard to the rejection of claim 1 also apply to the rejection of claims 12 and 21.

Dependent Claims

Claims 2 – 11 are dependent on claim 1 and claims 13 – 19 are dependent on claim 12. Applicants respectfully assert that claims 2 – 11 and 13 – 19 are allowable at least based on allowable base claims. Additionally, each of claims 2 – 11 and 13 – 19 may be allowable for further reasons.

CONCLUSION

Generally, in this Amendment and Response, Applicants have not raised all possible grounds for (a) traversing the rejections of the Action or (b) patentably distinguishing any new claims (i.e., over the Cited References or otherwise). Applicants however, reserve the right to explicate and expand on any ground already raised and/or to raise other grounds for traversing and/or for distinguishing, including, without limitation, by explaining and/or distinguishing the subject matter of the Application and/or any cited reference at a later time (e.g., in the event that this Application does not proceed to issue with the claims as herein amended, or in the context of a continuing application).

Applicants submit that nothing herein is, or should be deemed to be, a disclaimer of any rights, acquiescence in any rejection, or a waiver of any arguments that might have been raised but were not raised herein, or otherwise in the prosecution of this Application, whether as to the original claims or as to any of the new claims, or otherwise. Without limiting the generality of the foregoing, Applicants reserve the right to reintroduce one or more of the original claims in original form or otherwise so as to claim the subject matter

of those claims, both/either at a later time in prosecuting this Application or in the context of a continuing application.

Applicants respectfully request reconsideration of the claims in view of the remarks made herein. A notice of allowance is earnestly solicited.

At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account **50-4019** pursuant to 37 C.F.R. 1.25. Additionally, please charge any fees to Deposit Account **50-4019** under 37 C.F.R. 1.16, 1.17, 1.19, 1.20 and 1.21.

Respectfully submitted,

/mark a. wilson/

Date: November 12, 2009

Mark A. Wilson
Reg. No. 43,994

Wilson & Ham
PMB: 348
2530 Berryessa Road
San Jose, CA 95132
Phone: (925) 249-1300
Fax: (925) 249-0111